REMARKS

Claims 1-19, 21-24, 26-28, 31-39 are pending in the application. Claims 31-34 have been allowed.

Applicants thank the Examiner for the courtesies extended to their representative during the interview held on November 13, 2007. During the interview, Applicants' representative explained the reasons why the cited references fail to disclose or suggest the combination of elements defined by the pending claims. The patentable differences between the combination of elements defined by the pending claims and the cited references, as discussed during the interview, are described in further detail below.

Claims 35-39 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner stated:

> Claims 35 and 36 are directed to a system comprising only a controller by itself and do not appear in combination with another recited element of means, a situation comparable to *In re Hyatt*. These claims are therefore subject to an undue breadth rejection, since it encompasses all possible conceivable means for performing a stated function. Therefore, the specification is non-enabling for failing to disclose all possible means for performing the stated function. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor."

This rejection is respectfully traversed. As the action states, *In re Hyatt* dealt with what is an enabling disclosure for "means-plus-function" claims. Such claims include elements that are expressed as "a means or step for performing a specified function without the recital of structure, material or acts in supports thereof," and such claims are required by statute to be construed to cover the "corresponding structure, material, or acts described in the specification and equivalents thereof." See 35 USC 112, 6th paragraph.

The rejected claims do not include means-plus-function elements. Accordingly, the specification does not need to enable all possible "means" for performing the stated function as stated by the Examiner. Further, since the specification would enable one to perform the invention claimed in claims 35 and 36, this rejection should be withdrawn.

Claims 1-19, 35-39 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that "[t]he specification does not disclose the controller is configured to identify the current set of native values as associated with actual events when the current set of native values and the prior set of native values are substantially similar." This limitation is recited in originally filed claim 26. Accordingly, this limitation is supported by the application as filed.

Claims 35-39 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 35, the Examiner states that:

> Claim 35 is confusing since it is not clear as to whether applicant is trying to claim a message or a system. It is also confusing in that the controller has no relationship with the touch pad, it is not clear where are the current set of native values and the prior set of native values coming from?

Claim 35 claims a message in a computer system. The controller is part of the computer system including the touchpad assembly and the host device. As described in the specification, the native values are provided by the touch pad to the controller.

With respect to claim 36, the Examiner states that:

> Claim 36 is confusing in that the controller has no relationship with the touch pad, it is not clear where are the current set of native values and the prior set of native values coming from? In addition, the terms "capable of" also renders the claim vague and indefinite in that a positive recitation is missing.

Claim 36 claims a "touch pad system" that includes a controller. Paragraph [0020] describes such as system. As described in the specification, the native values are provided by the touch pad to the controller.

Claims 1-13, 15-19, 21-24, 26-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bertram in view of Meadows. This rejection is traversed.

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Claim 1 recites a number of elements in combination. The combination includes a touch pad assembly that includes a touch pad and a controller configured to 1) define one or more logical device units associated with the surface of the touch pad, 2) receive from the one or more sensors native values associated with the native sensor coordinates, 3) adjust the native values associated with the native sensor coordinates into new values associated with the logical device units, and 4) report the new values to a host device.

As explained in paragraph [0023], by performing the recited combination of elements, the controller can filter or convert the data from the touch pad before delivering the data to the host device. In this manner, the processing requirements on the host device can be diminished. The Examiner cites Bertram as showing a controller configured to perform the claimed combination of elements including converting native values to logical device units as claimed. This is incorrect. The cited portions of Betram disclose an operating system running on a computer system having the following capabilities: "(1) mapping out geometric regions of the touchpad and assign the regions to specific region identifiers responsive to application programs and (2) determining the region identifier of a touched region and passing that region identifier to the application program." (See Abstract). Consequently, in Betram the main CPU running the operating system performs the conversion. Accordingly, Bertram fails to disclose or suggest a combination including a controller configured to perform all the elements recited in claim 1.

Meadows is cited only to show filtering. Meadows, like Betram, fails to disclose or suggest the claimed combination of elements including a controller that performs the claimed conversion prior to reporting the converted data to the host device. Accordingly, the rejection of claim 1 should be withdrawn. The rejection of claims 2-13, and 15-19, which depend from claim 1, should similarly be withdrawn.

Independent claim 26 defines a combination that includes: 1) comparing a current set of native values with a last set of native values; 2) classifying the current set of native values as noise events when the current set of native values is substantially similar to the previous set of native values; and 3) classifying the current set of native values as actual events when the current set of native values is significantly different than the previous set of native values. Accordingly, the

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claimed combination results in only substantial changes in position being considered "actual events."

The Examiner cites Meadows as showing this combination of features. Meadows, however, fails to disclose or suggest a combination including the all the claimed elements. Instead, Meadows discloses a different combination of elements that define filtering techniques that vary the filtering in proportion to the rate of movement. See Meadows, col. 36, 1-17. Further, Meadows fails to classify values as actual events or noise events as claimed. Accordingly, Meadows fails to disclose or suggest the claimed combination of elements recited in claim 26. Claims 21-24, 27 and 28, which depend from claim 26, are patentable over the cited references for at least the same reasons.

Claim 14 stands rejected under 33 U.S.C. 103(a) as being unpatentable over Bertram and Meadows applied to claim 1 above, and further in view of Matzke.

Claim 14 depends from claim 1. Matzke is cited only to show angular Polar units distributed around the surface of the touch pad in a clock like manner. Since none of the cited references disclose or suggest combinations that include a controller that performs the claimed conversion prior to reporting the converted data to the host device as claimed in claim 1, this rejection should be withdrawn.

Claims 35, 36 and 38 are rejected under 33 U.S.C. 103(a) as being unpatentable over Yates in view of Meadows. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates and Meadows applied to claim 36 above, and further in view of Bertram.
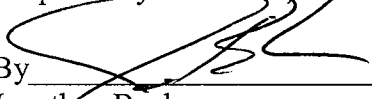
All of these claims include combinations that include comparing a current set of native values and a prior set of native values and identify the current set of native values as noise events or actual events depending on whether the current set of native values and the prior set of native values are substantially similar. The Examiner relies upon Meadows as showing a touch panel that includes this filtering technique. However, as described above, Meadows does not disclose or suggest the claimed combination of elements that includes classifying data as actual events or noise events depending on whether the current set of native values and the prior set of native values are substantially similar. Instead, Meadows discloses rate dependent filtering. Since none of the cited references disclose the claimed filtering techniques, these rejections of claims 35-38 should be withdrawn.

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In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **106842005400**.

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Respectfully submitted,

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